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EXAMINER
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HUYNH, KHOA D

ART UNIT	PAPER NUMBER
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3751

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/22/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/776,955

Applicant(s)

BREIDENBACH ET AL.

Examiner

Khoa D. Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-15, 17-28 and 31-52 is/are pending in the application.
- 4a) Of the above claim(s) 48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-15, 17-28, 31-47 and 49-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/11/04; 9/27/04; 11/03/06 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 11/3/06.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Species 1 in the reply filed on 11/03/06 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 2-15, 17-28, and 31-47 are readable on the elected species. Accordingly, claim 48 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected species.

The requirement is still deemed proper and is therefore made FINAL.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the driving member having a product contact surface that contacts the inside surface of the reservoir over a substantial portion of its surface as recited in claims 31, 32, 43 and 49-52 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

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and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 31, 32, 43 and 49-52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Claim 31 recites "the driving member having a product contact surface that contacts the inside surface of the reservoir over a substantial portion of its surface". However, such claimed subject matter was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Therefore, such claimed subject matter constitutes new matter. Claims 32, 43 and 49-52 suffer similar deficiency.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2-15, 17-28, 31, 32-42, 43 and 49-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 31 calls for "the driving member having a product contact surface that contacts the inside surface of the reservoir over a substantial portion of its surface". Such recitations render the claim indefinite since it does not have detailed supports in the instant specification. Since the claim does not clearly set forth the metes and bounds of the patent protection desired, the scope of the claim is unascertainable. Claims 2-15 and 17-28 depend on claim 31 and are likewise indefinite. Claims 32-42, 43 and 49-52 suffer similar deficiency.

#### ***Specification***

7. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the driving member having a product contact surface that contacts the inside surface of the reservoir over a substantial portion of its surface as recited in claims 31, 32, 43 and 49-52.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re*

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*Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 45 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 26 of USPN 6607323. Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons: pending claim 45 is slightly broader than patent claim 26 and is thus "anticipated" by patent claim 26. A pending claim that is anticipated by a previous claim is considered to not be patentably distinct therefrom.

Claims 15, 17-19, 31-35, and 44 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 22-24 of USPN 6,607,323 in view of USPN 5,879,095 (Gueret). Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons.

Regarding pending claims 31, 15, and 17, patent claim 22 recites an applicator having all of the features of pending claims 31, 15, and 17, except for the tip having an inner and outer surface which the orifice extends between, or that the drive means/driving member contacts an inner surface of the reservoir, or that the thickness of the sidewall of the reservoir is constant. However, the Gueret reference discloses a similar applicator whose tip (comprising portions 31, 3, and 6) has an outer and inner

surface (see Fig. 1) which orifice (61 and opening formed by tip portion 3) extends between for a convenient stop surface for the drive means (the inner surface) and for a convenient surface for contacting the product to a user's lips (the outer surface), whose driving member contacts an inner surface of the reservoir (see Fig. 2) to prevent leakage of product, and whose thickness of the sidewall of the reservoir is constant (see Fig. 2) for simple fabrication of the reservoir such that it does not require multiple wall thicknesses. It would have been obvious to modify the applicator of patent claim 22 such that the tip has an outer and inner surface which the orifice extends between in view of Gueret for a convenient stop surface for the drive means and for a convenient surface for contacting the product to a user's lips, such that the driving member contacts an inner surface of the reservoir in view of Gueret to prevent leakage of product, and whose thickness of the sidewall of the reservoir is constant in view of Gueret for simpler fabrication of the reservoir such that it does not require multiple wall thicknesses. Furthermore, respective pending claims 18 and 19 (which depend from pending claim 17) are substantially the same as or broader than respective patent claims 23 and 24 (which similarly depend from patent claim 22).

Regarding pending claims 32 and 33 (pending claim 33 depends from pending claim 32), patent claim 22 recites an applicator having all of the features of pending claims 32 and 33, except for the tip having an inner and outer surface which the orifice extends between, or that the drive means/driving member has a product contact surface that contacts the inner surface of the tip to remove as much product as possible from the reservoir. However, the Gueret reference discloses a similar applicator whose tip

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(comprising portions 31, 3, and 6) has an outer and inner surface (see Fig. 1) which orifice (61 and opening formed by tip portion 3) extends between for a convenient stop surface for the drive means (the inner surface) and for a convenient surface for contacting the product to a user's lips (the outer surface), and whose driving member 41 has a product contact surface which contacts the inner surface of the tip to remove as much product as possible from the reservoir (see Fig. 4) for maximizing efficient usage of the product in the applicator. It would have been obvious to modify the applicator of patent claim 22 such that the tip has an outer and inner surface which the orifice extends between in view of Gueret for a convenient stop surface for the drive means and for a convenient surface for contacting the product to a user's lips, and whose driving member has a product contact surface which contacts the inner surface of the tip to remove as much product as possible from the reservoir in view of Gueret for maximizing efficient usage of the product in the applicator. Furthermore, respective pending claims 34 and 35 (which depend from pending claim 33) are substantially the same as or broader than respective patent claims 23 and 24 (which similarly depend from patent claim 22).

Regarding pending claim 44, patent claim 27 recites an applicator having all of the features of pending claim 44, except for the tip having an inner and outer surface which the orifice extends between. However, the Gueret reference discloses a similar applicator whose tip (comprising portions 31, 3, and 6) has an outer and inner surface (see Fig. 1) which orifice (61 and opening formed by tip portion 3) extends between for a convenient stop surface for the drive means (the inner surface) and for a convenient



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surface for contacting the product to a user's lips (the outer surface). It would have been obvious to modify the applicator of patent claim 27 such that the tip has an outer and inner surface which the orifice extends between in view of Gueret for a convenient stop surface for the drive means and for a convenient surface for contacting the product to a user's lips.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 15, 17-19, 31-35, 43, 49, 51 and 52, as best understood and give the broadest reasonable interpretations, are rejected under 35 U.S.C. 102(b) as being anticipated by Gaebel (4622984).

Regarding claim 31, the Gaebel reference discloses an applicator capable of applying pasty product to a user's lips comprising a body 11a, a hollow product reservoir 16, a tip (10 and 11b) having an outer surface and an inner surface (see Fig. 2), an orifice extending between the inner and outer surface (passageway between the inner and outer surface of the tip), a driving member 24 which contacts the inside surface of the reservoir and rides along screw means 21, the thickness of the reservoir sidewall being constant (see Fig. 2), and wherein the user can view the color of the product in the reservoir (via window 13). As schematically shown in Figure 3, the driving member

24 has a product contact surface that contacts the inside surface of the reservoir over a substantial portion of its surface.

Regarding claim 15, the product reservoir side wall is round (see Fig. 3).

Regarding claim 17, the Gaebel drive means is disk 22 supporting screw means/driving member 24.

Regarding claims 18 and 19, the screw means is prevented from turning by guide member 13 which extends from the interior wall of the reservoir (see Fig. 3) which mates with a recess in the driving member (Fig. 3).

Regarding claim 32, the Gaebel reference discloses an applicator capable of applying pasty product to a user's lips comprising a body 11a, a hollow product reservoir 16, a tip (10 and 11b) having an outer surface and an inner surface (Fig. 2), an orifice extending between the inner and outer surface (passageway between the inner and outer surface of the tip), a driving member 24 which has a product contact surface which contacts the inner surface of the tip to remove as much product as possible from the reservoir (see Fig. 3), and a screw means 21, and wherein the user can view the color of the product in the reservoir (via window 13). As schematically shown in Figure 3, the driving member 24 has a product contact surface that contacts the inside surface of the reservoir over a substantial portion of its surface.

Regarding claim 33, the Gaebel drive means is disk 22 supporting screw means/driving member 24.

Regarding claims 34 and 35, the screw means is prevented from turning by guide member 13 which extends from the interior wall of the reservoir (see Fig. 3) which mates with a recess in the driving member (see Fig. 3).

Regarding claim 43, the Gaebel reference discloses an applicator capable of applying pasty product to a user's lips comprising a body 11a, a hollow product reservoir 16, a tip (10 and 11b) having an outer surface and an inner surface (see Fig. 2), an orifice extending between the inner and outer surface (passageway between the inner and outer surface of the tip), a driving member 24 which has a product contact surface generally parallel to the inner surface of the tip (see Fig. 2), and a screw means 21, and wherein the user can view the color of the product in the reservoir (via window 13). As schematically shown in Figure 3, the driving member 24 has a product contact surface that contacts the inside surface of the reservoir over a substantial portion of its surface.

Regarding claim 49, the Gaebel reference discloses an applicator capable of applying pasty product to a user's lips comprising a body 11a, a hollow product reservoir 16, a tip (10 and 11b) having an outer surface and an inner surface (Fig. 2), an orifice extending between the inner and outer surface (passageway between the inner and outer surface of the tip), and a means for discharging/driving member 24 which has a flat product contact surface across its entire surface, and wherein the user can view the color of the product in the reservoir (via window 13). Also, as schematically shown in Figure 2, the outer surface of the tip is being slightly concave. Furthermore, as schematically shown in Figure 3, the driving member 24 has a product contact surface that contacts the inside surface of the reservoir over a substantial portion of its surface.

Regarding claim 51, the Gaebel reference discloses an applicator capable of applying pasty product to a user's lips comprising a body 11a, a hollow product reservoir 16, a tip (10 and 11b) having an outer surface and an inner surface (Fig. 2), an orifice extending between the inner and outer surface (passageway between the inner and outer surface of the tip), and a means for discharging/driving member 24 which has a flat product contact surface across its entire surface, and wherein the user can view the color of the product in the reservoir (via window 13). Furthermore, as schematically shown in Figure 3, the driving member 24 has a product contact surface that contacts the inside surface of the reservoir over a substantial portion of its surface.

Regarding claim 52, the Gaebel reference discloses an applicator capable of applying pasty product to a user's lips comprising a body 11a, a hollow product reservoir 16, a tip (10 and 11b) having an outer surface and an inner surface (Fig. 2), an orifice extending between the inner and outer surface (passageway between the inner and outer surface of the tip), and a means for discharging/driving member 24 which is a flat disk (Fig. 3) having a top surface and a bottom surface and wherein the top surface and the bottom surface are substantially parallel to each other over their entire surface, and wherein the user can view the color of the product in the reservoir (via window 13). Furthermore, as schematically shown in Figure 3, the driving member 24 has a product contact surface that contacts the inside surface of the reservoir over a substantial portion of its surface.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 46 and 47, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Gaebel (4622984).

Regarding claim 46, the Gaebel reference discloses an applicator capable of applying pasty product to a user's lips comprising a body 11, the body having a product reservoir 16 extending therefrom, the product reservoir being hollow and having a tip (about 11b & 17) extending from an end opposite the body, the reservoir having means for discharging the product through an orifice (constituted by the opening portion where element 23 located), the means for discharging including a driving member 24 which has a flat product contact surface across its entire surface. Even though the Gaebel reference does not specifically disclose that the color of the product in the reservoir could be viewed through the tip as claimed, it, however, would have been obvious to one of ordinary skill in the art to recognize that when the portion 30 is removed, a user would be able to view the color of the product in the reservoir through the tip.

Regarding claim 47, the Gaebel reference discloses an applicator capable of applying pasty product to a user's lips comprising a body 11, the body having a product reservoir 16 extending therefrom, the product reservoir being hollow and having a tip (about 11b & 17) extending from an end opposite the body, the reservoir having means

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for discharging the product through an orifice (constituted by the opening portion where element 23 is located), the means for discharging including a driving member 24 which is a flat disk having a top surface and a bottom surface and wherein the top surface and the bottom surface are generally parallel to each other over their entire surface. Even though the Gaebel reference does not specifically disclose that the color of the product in the reservoir could be viewed through the tip as claimed, it, however, would have been obvious to one of ordinary skill in the art to recognize that when the portion 30 is removed, a user would be able to view the color of the product in the reservoir through the tip.

12. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gueret (5879095).

The Gueret reference discloses an applicator for applying product to a user's lips comprising a body 2 with a hollow reservoir (portion other than tip portions 31 and 3 containing product P, see Fig. 2), a tip (comprising portions 31, 3, and 6) having an outer and inner surface (Fig. 1), an orifice (61) and opening formed by tip portion 3), wherein the outer surface of the tip being optionally slightly concave (Figs. 6 & 7). Even though the Gueret reference does not specifically disclose that the color of the product in the reservoir could be viewed through the tip as claimed, it, however, would have been obvious to one of ordinary skill in the art to recognize that when the cap is removed, a user would be able to view the color of the product in the reservoir through the tip.

13. Claims 2-5, 15, 17, 18, 20, 24, 31-34, 36 and 40 rejected under 35 U.S.C. 103(a) as being unpatentable over Gueret (5879095) in view of Lang (5842802).

Regarding claims 31, 2-4, and 20, the Gueret reference discloses an applicator for applying product to a user's lips comprising a body 2 with a hollow reservoir (portion other than tip portions 31 and 3 containing product P, see Fig. 2), a tip (comprising portions 31, 3, and 6) having an outer and inner surface (Fig. 1), an orifice (61 and opening formed by tip portion 3), a driving member (constitute portions 4, 41, 42, 43, 43a) which contacts the inside of the reservoir (Fig. 2), screw means 51, the sidewall of the reservoir having a constant thickness (see Fig. 2), and a cap 8. The Gueret reference DIFFERS in that it does not specifically disclose that a user can view product in the reservoir via a viewing window at the top, a transparent reservoir exterior, and a hand hold adhered to the reservoir comprising a window. Attention, however, is directed to the Lang reference which discloses a similar applicator having a cap 34a with transparent top and sidewalls (col. 4, lines 40-48) and a reservoir exterior with a hand hold 30 adhered to the reservoir, the reservoir/hand hold optionally transparent (see col. 2, lines 33-37) thus forming viewing windows in the cap and hand hold so that the user can see the contents of the applicator and more easily grip the applicator. Therefore, it would have been obvious to employ a viewing window at the top and sides of the Gueret cap and a transparent reservoir exterior/adhered hand hold on the Gueret reservoir thus forming viewing windows in the cap and hand hold in view of Lang so that the user could see the contents of the applicator and more easily grip the applicator.

Regarding claim 5, although the Gueret reference remains silent as to the material of the cap. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the cap from PETG, since it has been held to be

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within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In Re Leshin*, 125 USPQ 416.

Regarding claim 15, the reservoir has a round side wall (Gueret Fig. 5).

Regarding claim 17, the Gueret applicator further includes disk 7.

Regarding claim 18, the Gueret applicator further includes guide member 43.

Regarding claim 24, the tip in the embodiment of Fig. 9 includes a perimeter canal 15 (col. 8, lines 14-19).

Regarding claims 32 and 36, the Gueret reference discloses an applicator for applying product to a user's lips comprising a body 2 with a hollow reservoir (portion other than tip portions 31 and 3 containing product P, see Fig. 2), a tip (comprising portions 31, 3, and 6) having an outer and inner surface (see Fig. 1), an orifice (61 and opening formed by tip portion 3), a driving member (constitute portions 4, 41, 42, 43, 43a) having a product contact surface which contacts the inner surface of the tip to remove as much product as possible from the reservoir (see Fig. 4), and a screw means 51. The Gueret reference DIFFERS in that it does not specifically disclose that a user can view product in the reservoir or a hand hold adhered to the reservoir comprising a viewing window. Attention, however, is directed to the Lang reference which discloses a similar applicator having a reservoir exterior with a hand hold 30 adhered to the reservoir, the reservoir/hand hold optionally transparent (see col. 2, lines 33-37) thus forming a viewing window in the hand hold so that the user can see the contents of the applicator and more easily grip the applicator. Therefore, it would have been obvious to



employ a transparent reservoir exterior/adhered hand hold on the Gueret reservoir thus forming a viewing windows in the hand hold in view of Lang so that the user can see the contents of the applicator and more easily grip the applicator.

Regarding claim 33, the Gueret applicator further includes disk 7.

Regarding claim 34, the Gueret applicator further includes guide member 43.

Regarding claim 40, the tip in the embodiment of Fig. 9 includes a perimeter canal 15 (see col. 8, lines 14-19).

14. Claims 6-14, as presently understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Gueret (as discussed supra) in view of Trabattoni (CH 623467).

Regarding claims 6 and 8, the Gueret reference discloses an applicator having substantially all features as discussed supra, except an opening in the body to receive a top portion of another container. Attention, however, is directed to the Trabattoni reference which discloses a similar applicator whose body has an opening to receive a top portion of another container for convenient transport of nail polish. Therefore, it would have been obvious to one of ordinary skill in the art to employ an opening in the body of the Gueret applicator to receive a top portion of another container, in view of Trabattoni, for conveniently transport of nail polish.

Regarding claims 7 and 9-14, although the modified Gueret reference does not disclose the other listed products, it would have been obvious to utilize the modified Gueret applicator to transport other listed products, as all such products are equally desirable to be transported for cosmetic purposes.

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15. Claims 21-23, 25, 26, 37-39, 41, 42 and 50, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Gueret (as discussed supra) in view of Kapustin (4740097).

Regarding claim 21, the Gueret reference discloses a lip product applicator as discussed supra, except the teardrop-shaped surface of the tip. Attention, however, is directed to the Kapustin reference which discloses another lip product applicator having a tip with a teardrop-shaped surface for applying product to a user's lips (col. 3, line 49) for decorative purposes. Therefore, it would have been obvious to modify the tip of the Gueret applicator to have a teardrop-shaped surface in view of Kapustin for decorative purposes.

Claim 50 recites limitations that are substantially similar to the limitations recited in claims 31 and 21 which have been rejected as discussed supra.

Regarding claim 22, the tip is optionally slightly concave (see Figs. 6 and 7).

Regarding claims 23, 25, 26, and 41, the tip optionally includes a plurality of canals 61 including a downward vertical canal and a horizontal canal (Fig. 16 and col. 8, lines 58-62).

Regarding claim 37, the Gueret reference discloses a lip product applicator as discussed supra, except the teardrop-shaped surface of the tip. Attention, however, is directed to the Kapustin reference which discloses another lip product applicator having a tip with a teardrop-shaped surface for applying product to a user's lips (col. 3, line 49) for decorative purposes. Therefore, it would have been obvious to modify the tip of the

Gueret applicator to have a teardrop-shaped surface in view of Kapustin for decorative purposes.

Regarding claim 38, the tip is optionally slightly concave (Figs. 6 and 7).

Regarding claims 39 and 42, the tip optionally includes a plurality of canals 61 including a downward vertical canal and a horizontal canal (Fig. 16 and col. 8, lines 58-62).

16. Claim 27, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Gueret (as discussed supra) in view of Green (4887924).

The Gueret reference discloses an applicator as discussed supra and further including plug 82, but does not disclose that the plug is inserted into the orifice. Attention, however, is directed to the Green reference which discloses a similar applicator having a plug inserted into the orifice (Fig. 4) for improved sealing of the orifice. Therefore, it would have been obvious to one of ordinary skill in the art to have modify the modified Gueret device by employing a plug inserted into the orifice, in view of the teaching of Green, for improved sealing of the orifice.

17. Claim 28, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Gueret (as discussed supra) in view of Penn (2094021).

The Gueret reference discloses an applicator as discussed supra, but does not disclose that the plug is adhered to the cap by a protrusion on the inside surface of the cap that is wider at its tip than its base and mates with the side of the plug opposite the orifice. Instead, the protrusion is integral with the cap. However, the Penn reference

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discloses a cap with a sealing plug (Fig. 4) wherein the plug 37 is adhered to the 42 by a protrusion 43 on the inside surface of the cap that is wider at its tip 21 than its base and mates with the side of the plug opposite the end that is inserted into the opening so that the plug can be made from a specialized plug material different from that of the cap. It would have been obvious to modify the modified Gueret applicator so that the plug is adhered to the cap by a protrusion on the inside surface of the cap that is wider at its tip than its base and mates with the side of the plug opposite the orifice in view of Penn so that the plug can be made from a specialized plug material different from that of the cap.

18. Claim 45, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Gueret (5879095) in view of Kapustin (4740097).

The Gueret reference discloses an applicator for applying product to a user's lips comprising a body 2 with a hollow reservoir (portion other than tip portions 31 and 3 containing product P, see Fig. 2), a tip (comprising portions 31, 3, and 6) having an outer surface (Fig. 1), an orifice (61 and opening formed by tip portion 3), and means for discharging product 41, except the teardrop-shaped surface of the tip or that a user can view the color of the product in the reservoir through the tip. Regarding the limitation the "teardrop-shaped outer surface", attention is directed to the Kapustin reference which discloses another lip product applicator having a tip with a teardrop-shaped surface for applying product to a user's lips (col. 3, line 49) for decorative purposes. Therefore, it would have been obvious to modify the tip of the Gueret applicator to have a teardrop-shaped surface in view of Kapustin for decorative purposes. Furthermore,

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even though the Gueret reference does not specifically disclose that the color of the product in the reservoir can be viewed through the tip as claimed, it, however, would have obvious to one of ordinary skill in the art to recognize that when the cap is removed, a user would be able to view the color of the product in the reservoir through the tip.

***Response to Amendment***

19. Applicant's amendment, filed on 11/03/06, to the pending claims is insufficient to distinguish the claimed invention from the cited prior art or overcome the rejections as discussed above.

***Response to Arguments***

20. Applicant's arguments filed on 11/03/06 with respect to the pending claims have been fully considered. However, such arguments are deemed not persuasive.

Applicant asserts that none of the cited references teach the amended limitations "the driving member having a product contact surface that contacts the inside surface of the reservoir over a substantial portion of its surface" as claimed in the amended claims. See remarks section, pages 18-19. The examiner disagrees.

Firstly, such amended limitations do not have any support in applicant's original disclosure. An inspection of applicant's specification yields only a short description at page 12, lines 12-14 of the "driving member 27." Furthermore, applicant's Figure 6c is described as showing the "driving member 27 as a round disk-like member" and not the "driving member having a product contact surface that contacts the inside surface of the

reservoir over a substantial portion of its surface." Therefore, such claimed subject matter constitutes new matter.

Lastly, as stated in the above rejections, the Gaebel reference, for example, does disclose an applicator having a driving member 24 (as a round disk-like member) including a product contact surface that contacts the inside surface of the reservoir over a substantial portion of its surface. The Gaebel driving member 24 is similar to applicant's Figure 6c which merely shows the "driving member 27" to be a round-disk like member. Therefore, the examiner's interpretation of "the driving member" in the amended claims to be reasonable in light of applicant's limited description of his driving member 27. *Phillips, 415 F.3d at 1315-17, 75 USPQ2d at 1327-29.*

Applicant also asserts that none of the cited references teach the amended limitations "wherein a user can view the color of the product in the reservoir through the tip" as claimed in the amended claims. See remarks section, page 19. The examiner disagrees.

Again, as stated in the above rejections, the Gueret reference, for example, discloses an applicator including a tip. Even though the Gueret reference does not specifically disclose that the color of the product in the reservoir can be viewed through the tip, it, however, would have obvious to one of ordinary skill in the art to recognize that when the cap is removed, a user would be able to view the color of the product in the reservoir through the tip.

Similar arguments can be made for other cited references.

***Conclusion***

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

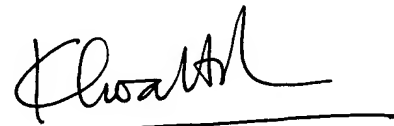
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoa D. Huynh whose telephone number is (571) 272-4888. The examiner can normally be reached on M-F (7:00-3:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on (571) 272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Khoa D. Huynh', is written over a horizontal line.

Khoa D. Huynh  
Primary Examiner  
Art Unit 3751

HK  
01/10/2007